

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application in condition for allowance.

Pursuant to the provisions of 37 C.F.R. §§ 1.17(a) and 1.136(a), Applicants petition the Assistant Commissioner to extend the time period for Applicants to respond to the outstanding Office Action by three (3) months, i.e., up to and including September 12, 2003. A check for \$930.00 is enclosed with this Amendment. Applicants authorize the Assistant Commissioner to charge any additional fee for consideration of this amendment, or credit any overpayment, to Deposit Account No. 50-0320.

Claims 16 and 23-42 are pending. Claims 29 and 32 were amended and claims 38-42 were added, without prejudice. Applicants reserve the right to pursue cancelled subject matter in a continuation application.

The amendments to the claims and the remarks made herein are not made for reasons related to patentability and, thus, do not prevent the application of the doctrine of equivalents. Support for new claims 38-42 is found throughout the specification.

No new matter is added.

Claims 23, 24, 26-28 and 32-34 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Johnson et al., U.S. Patent No. 6,165,939 to Agbaje et al., WO 98/09525 to Novartis AG, Harvey et al. CROPU Abstract 1996-90386, "Soybean Herbicide Studies," *Res. Rep. North Cent. Weed Sci. Soc.*, (52:316-20) 1995, and Steckel et al. CROPU Abstract 1996-90678, "Weed Control in Glufosinate Tolerant Soybeans," *Res. Rep. North Cent.*

Weed Sci. Soc., (52:336-38), 1995. Applicants continue to respectfully disagree. None of the cited documents teaches, suggests or motivates a skilled artisan to practice the instantly claimed invention.

More specifically, in order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Against this background, none of the cited documents, either alone or in combination, teaches, suggests or discloses the instantly claimed invention. Agbaje relates to a specific co-formulation of the type "suspoemulsion", which purportedly provides for a stable storage of the aqueous, oily and solid active ingredients. In no part of this document, however, is there a teaching or motivational recitation of the synergistic use of the composition, according to the present application, in comparison to the individual components. Even the report of the biological greenhouse experiments in examples 12 and 16 of the document, fail to motivate one skilled in the art to practice the instantly claimed invention.

Novartis is equally defective. Novartis provides no biological examples to support its assertions. Indeed, mere test descriptions for pre- and post emergence treatments were purported, without naming crops, herbicidal mixtures or detailed results. Applicants respectfully assert that Novartis renders a selection impossible and puts an undue burden on one skilled in the art to discover what technical teaching should be used to obtain the instantly claimed invention.

With respect to the Harvey and Steckel documents, neither of these two documents teach, suggest or motivate a skilled artisan to practice the instantly claimed invention. Further, Applicants do not believe in the propriety of the Section 103 rejection based on these documents because the instantly claimed synergistic effects were obtained with combinations not taught or suggested by Harvey and Steckel.

Again, it is respectfully reemphasized that the Federal Circuit in *In re Fine* was very clear that “obvious to try” is not the standard upon which an obviousness rejection should be based. And as “obvious to try” would be the only standard that would lend the Section 103 rejection any viability, the rejection must fail as a matter of law.

Moreover, the instant invention exhibits unexpected results and superiority over the art and, thus, rebuts any holding of *prima facie* obviousness. Reference is again made to the Declaration of Dr. Hacker, which was previously submitted. Dr. Hacker notes that:

- The data in Tables 1 to 9 of the Declaration demonstrate that the herbicidal effect of the tested combinations according to the invention was higher, in some cases considerably higher, than the effects of the individual herbicides (according to E^A - resp. E^C - values), i.e. activity which is far better than one of ordinary skill in the art would have expected; and

An important advantage of the inventive combinations is that significant control is obtained with a combination of relatively low dosages of the components. The claimed composition results in only minimal damage to the crop plant. The use of lower doses is an important factor since lower doses or application rates not only provide for a higher percentage of weed damage, but also provide economic advantages to the farmer and an overall ecological advantage, as less herbicide has to be purchased and used. Accordingly, the claimed invention also provides for unexpected economic and ecological advantages.

Although Applicants thank the Examiner for indicating that claims drawn to the species lactofen, alachlor and haloxyfop would be allowable (Office Action, at 6), Applicants respectfully disagree with the allegation that the claims are so broad as to fall outside of the scope of the Declaration. The instant application and the Hacker declaration are replete with synergism data that supports Applicants' belief that the instant invention exhibits unexpected results and superiority over the art. More specifically, the synergism data in the application and in Dr. Hacker's declaration—e.g., glufosinate with: alachlor (Table 3); thiensulfuron-methyl (Table 5); chlorimuron (Table 6); flumiclorac-pentyl (Table 8); imazamox (Declaration Table 6); etc. is representative of the scope of the claimed invention and is sufficient to render the obviousness rejection moot.

Thus, the results were unexpected and provide evidence of the superiority of the instant invention over the cited art. Therefore, even if it was so held that a person with ordinary skill in the art would have been motivated to practice the instant invention from a reading of the cited art, a point Applicants do not concede, the declaration submitted herewith and the conclusions contained therein clearly rebut such a holding since the cited art does not suggest that

Applicants' invention would exhibit such superior results. The claimed invention, therefore, is unobvious.

Consequently, even if a *prima facie* case of obviousness were established, a point Applicants do not concede, the previously submitted declaration rebuts such a holding and the rejections of the claims should be removed accordingly.

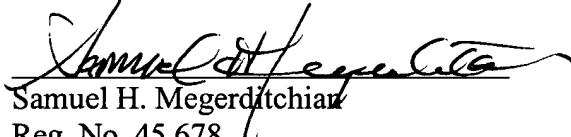
Therefore, reconsideration and withdrawal of the Section 103 rejections based on the preceding documents are respectfully requested.

Favorable consideration of the claims is earnestly solicited. If, however, there is still an outstanding issue, the Examiner is invited to contact the undersigned for its prompt attention.

Respectfully submitted,

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